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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,825	03/08/2000	Kelli Hustad Hueler	HUEC.300USO1	1844

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EXAMINER	
DASS, HARISH T	

ART UNIT	PAPER NUMBER
3628	

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/520,825	HUELER ET AL.	
	Examiner	Art Unit	
	Harish T Dass	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 March 0204*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, particularly, an abstract idea.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 4, 6-10 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Field (US Pat. 6,073,104) in view of Crozier (US Pat. 5,666,553).

Re. Claims 1, 8 and 10 Field discloses a computerized system that will allow healthcare providers to access the commercial paper market by "selling" their patient claims to asset backed commercial paper conduits (financial transactions) [see entire document particularly - Abstract; Figures 3, 5, 12-13, 17, 22-23, 27-29, 33, 52A-55; C1 L5-L56; C2 L45 to CC4 L23; C4 L65 to C5 L5; C6 L30 to C7 L67; C8 L60 to C10-L48; C15 L1-L7;

C16 L14-L40; C24 L4-L27], defining an import specification identifying database format characteristics of investment plan information stored in a first database and importing the investment plan information into the predefined data fields of the second database according to the import specification (defining export specification that defines what data items are in each field in the download file or imported file from provider account system to SPE and is saved in collection tables) [C2 L45 to C3 L20; C3 L45-L67; C4 L7-L21; C8 L52 to C9 L1, C9 L52 to C10 L50; C24 LL4-L15; Figures 12A, 12B, 17, 27, 54A/B], transferring (transmitting) the investment plan information to a central database accessible by the investment contract sellers authorized (approved, approved payor) by the investment contract buyers to receive the investment plan information [C14 L18-L30; C23 L15-L23; Figures 23A/B], transferring the investment plan information from the central database to the authorized investment contract sellers upon initiation by the authorized (approved, approved payor) investment contract sellers [C14 L18-L30; C23 L15-L23; Figures 23A/B], creating a proposed investment contract from the investment plan information received via the central database (capturing and manipulates source data contract between the SPE and the receivable seller and generating report or contract) [C5 L14-L30, L45-L50; C16 L14], data capturing, downloading data in variety of file languages [C15 L1-L7] and computer-readable medium (hard drive) [C7 L21]. Field does not explicitly disclose data import map and mapping data fields from the first database to data fields in a second database to create a data import map, wherein the data fields in the second database are predefined data fields. However, Crozier discloses these steps [Abstract; C1 L22 to C2 L18; C3 L1 to C4 L67] and uses this

mapping to translate the data of a file from the source record structure to the destination record structure. It would have been obvious to one of ordinary skill in the art database embedded programming at the time the Applicant's invention was made to combine disclosures of Field and Crozier and include database mapping to accept data from a first computer application, and then mapping and translating the data to the formats expected by a second computer application.

Re. Claims 4 and 6, claims 4 and 6 are rejected with same rational as claims 1, 8 and 10, see above.

Re. Claim 9, Field discloses second computing device having a storage, and a user interface to interface to the second computing device, wherein the user interface includes at least a display (I/O) [C7 L8 to C9 L14; C13 L43], means for entering data [C7 L38-L54], and wherein the second computing device comprises second data transfer means for transferring the investment plan information (data) from the central database to the authorized investment contract sellers upon initiation by the authorized investment contract sellers and upon release of the investment plan information [C14 L18-L30; C23 L15-L23; Figures 23A/B] and means for viewing the investment plan information received via the central database by the investment contract sellers (display) [C16 L30-L48].

Claims 2-3, 5 & remain rejected under 35 U.S.C. 103(a) as being unpatentable over Field in view of Crozier as applied to claim 1 above, and further in view of Tozzoli et al (Hereinafter Tozzoli, US Pat. 6,151,588).

Regarding claim 2, 3, 5 and 7 Field discloses computerized information management system to create and access commercial paper market to sell claims to asset backed commercial paper conduits and approval (see claim 1). Field, explicitly, does not disclose authorization code and notification. However, Tozzoli disclose a computer system that facilitates trade in goods and services, transmitting notification, purchase order and authorization code [see entire document particularly - Abstract; C1 L2-L40; C13 L1 to C14 L65] permits the buyer/seller to send the draft proposed purchase order data to the seller/buyer and to notify buyer (seller) of seller (buyer) offers having certain characteristics and offers which meet the buyer's terms (seller's terms). It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to modify disclosure of Field and include authorization code to allow authorized user to access the system and notification to timely inform the user (seller/buyer) of any changes in contract, approval, acceptance, etc.

Response to Arguments

3. Applicant's arguments filed 3/19/2004 have been fully considered but they are not persuasive.

Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See In re Musgrave, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See Diamond v. Diehr, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful,

concrete and tangible result." See State Street Bank & Trust Co. v. Signature Financial Group, Inc. 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See In re Toma, 197 USPQ (BNA) 852 (CCPA 1978). In Toma, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to Gottschalk v. Benson, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. In re Toma at 857.

In Toma, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in State Street Bank & Trust Co. v. Signature Financial Group, Inc. never addressed this prong of the test. In State Street Bank & Trust Co., the court

found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See State Street Bank & Trust Co. at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under °101, but rather under §§102, 103 and 112." See State Street Bank & Trust Co. at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, State Street abolished the Freeman-Walter-Abele test used in Toma. However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in Toma because the invention in State Street (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the Toma test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See Ex parte Bowman, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, Claims 1-7 have no connection to the technological arts. None of the steps indicate any connection to a computer or technology. Therefore, the claims are directed towards non-statutory subject matter. To overcome

this rejection the Examiner recommends that Applicant amend the claims to better clarify which of the steps are being performed within the technological arts; for example: "computer is used to calculate average ..."

In response to Applicant's remarks regarding claims 1-10, Examiner has provided detail references for each limitations and motivation to combine the reference which are stated in prior art them self.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T Dass whose telephone number is 703-305-4694. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S Sough can be reached on 703-308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harish T Dass
Examiner
Art Unit 3628

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